



## REMARKS/ARGUMENT

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### Regarding the New Claims Submitted Herein:

Claims 1-24 have been cancelled without prejudice and been replaced by new claims 26-49. Claims 26-37 are directed to invention I as defined by the Examiner, and claims 38-49 are directed to invention II.

Claim 25, directed to non-elected invention III, is withdrawn from further consideration at this time.

The new apparatus claims are presented in structural, rather than means plus function form, and claims 13-24 have been rewritten to conform better to U.S. claim practice. The scope of the new claims has not, however, been narrowed.

### Regarding the Traverse of the Requirement for Restriction:

Applicants respectfully traverse the requirement for restriction on the ground that inventions I and II are neither independent nor distinct, and should not be covered by separate patents. The requirement for restriction is *not traversed* relative to invention III.

According to M.P.E.P. § 806, "... (C) Where inventions are related as disclosed but are not distinct as claimed, restriction is never proper." M.P.E.P. § 806.04 gives an example of when apparatus and process claims are independent (i.e., unrelated) as follows:

(B) Where the two inventions are process and apparatus, and the apparatus cannot be used to practice the process or any part thereof, they are independent. A specific process of molding is independent from a molding apparatus which cannot be used to practice the specific process.

Inventions I and II are not independent according to the foregoing test. The apparatus covered by claims 26-37 can clearly be used to perform the process covered by claims 38-49.

Nor are the inventions distinct as claimed. Contrary to the Examiner's assertion, the apparatus covered by claims 26-37 can not be used to practice another and materially different process. It is respectfully submitted that the examiner has incorrectly focused on the references in

original claims 1 and 13 to the material being worked on, i.e., solder balls, and has completely ignored the apparatus and process steps which really comprise the claimed invention.

The Examiner surely recognizes that, for purposes of examination, references to material being worked are generally not treated as imparting patentability to apparatus claims. Thus, the search will be extended as broadly as can be justified from the elements recited.

Likewise, in examining method claims, related apparatus and process arts will be searched, again based on the broadest reasonable interpretation that can be given to the steps recited in the claims.

In particular, while the invention is described in relation to creating an array of solder balls for semiconductor device fabrication, the claims now pending will (and should) be treated for purposes of examination as broadly directed to an apparatus and a process for arraying a plurality of elements which need to be treated gently. This will be apparent from comparing the following corresponding limitations of claims 26 and 38:

Apparatus Claim	Process Claim
a mechanism constructed and configured to apply a force to the solder balls in the container in the direction of movement of the container as the container moves between the first position to the second position.	applying a force to the solder balls in the container in the direction of movement of the container as the container moves between the first position to the second position thereby to reduce or obviate damage to the solder balls during such movement

It will also be apparent that an apparatus including the above-recited element can simply not be used to practice a process which is materially different from that of claim 38 when the above-quoted process limitation is given proper consideration.

In any event, assuming the Examiner has properly stated the classification of Inventions I and II, it is respectfully submitted that he will have to search both of these arts, and other arts related to apparatus and methods for positioning a plurality of elements, no matter which of the two inventions is elected.

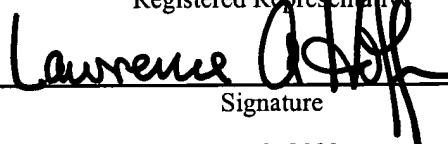
For the foregoing reasons, the Examiner is respectfully requested to reconsider his holding that Inventions I and II are distinct, and to group claims 26-49 together for purposes of examination.

In view of the foregoing, favorable reconsideration and examination of claims 26-49 on the merits are respectfully solicited.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 9, 2003

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Name of applicant, assignee or  
Registered Representative

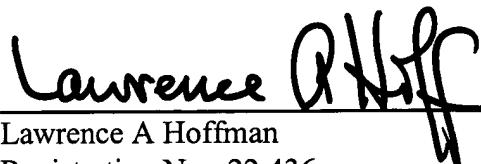


Signature

June 9, 2003

Date of Signature

Respectfully submitted,



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